

PATENTS
15343-0028C3

13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
Theodore Spielberg)
Serial No.: 09/928,392)
Filed: August 13, 2001)
For: MICROPOROUS ENCAPSU-)
LATED ENDOCRINE CELL)
DISKS, BICONCAVE DISKS)
AND MULTIDIMPLED)
CHAMBERS FOR HORMO-)
NAL REPLACEMENT)

Examiner: Nickol, G.

Art Unit: 1642

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
May 31, 2005

"Express Mail" Mailing-Label Number: EV 432397045 US

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 C.F.R. §1.137(a) AND 37 C.F.R. §1.181, OR, IN THE ALTERNATIVE,
PURSUANT TO 37 C.F.R. §1.137(b)

The Applicant respectfully renews his petition under 37 C.F.R. §1.137(a) and §1.181 to revive the above-referenced patent application, which was unavoidably abandoned for failure to receive an Office action mailed on March 19, 2004. The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(a) was unavoidable.

A Notice of Abandonment was mailed by the PTO on December 2, 2004 because the Applicant did not file a timely reply to the Office action dated March 19, 2004. Upon receipt of this notice, Applicant confirmed that the PTO correspondence address associated with this application is up-to-date. In addition, the Applicant prepared a Petition to Revive Under 37 C.F.R. §1.137(a), which petition was mailed on December 21, 2004, to establish that the Office action dated March 19, 2004 had not been received by the Applicant or by his representatives.

Applicant's Petition to Revive was dismissed for failing to submit a reply to the non-received Office action and for failing to present evidence that the non-received Office action had not been misdocketed to another matter. In response, the Applicant hereby concurrently submits a response to the non-received Office action, pursuant to 37 C.F.R. §1.116, and a Declaration of Stephen Kabakoff ("Kabakoff Declaration") averring that the missing Office action had not been misdocketed. Accordingly, the Applicant submits that the noted deficiencies in the Applicant's previous petition have been cured and that the above-referenced patent application should be revived and remanded to the patent examiner for further prosecution.

The Kabakoff Declaration, attached herewith as Exhibit 1, attests that Office actions received at the law firm of Cesari and McKenna, LLP, are entered into a docketing system as a matter of business practice before the Office actions are acted upon by attorneys and agents in the firm. The Kabakoff Declaration further avers that Office actions entered into the docketing system are sorted based on their three-month due dates, and the docketing system did not include an entry for the non-received Office action between the dates of June 19, 2004 and June 21, 2004. The Kabakoff Declaration attests that the case files for other applications whose due dates were between June 19, 2004 and June 21, 2004 have been searched, and that these other case files do not contain the missing Office action. Accordingly, the non-received Office action was not mistakenly misdocketed into a case file having a response due on the same date as the instant application.

The Applicant also encloses a copy of the Declaration of Rocio Archila (“Archila Declaration”), which was filed in the Applicant’s previous Petition to Revive. A copy of the Archila Declaration is attached herewith as Exhibit 2. The Archila Declaration attests to the fact that a search of the file jacket and docket records relating to this patent application indicate that the Office action of March 19, 2004 was not received. The Archila Declaration provides a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed. The Archila Declaration further attests to the fact that the non-received Office action would have been docketed on the docket record for this patent application.


Based upon the totality of this information, Applicant respectfully requests that the Commissioner grant this renewed Petition and withdraw the notice of abandonment that has been entered in this application file.

A check for \$ 250 is enclosed to cover the Petition Fee pursuant to 37 C.F.R. §1.17(l).

In the alternative, the Applicant respectfully requests that the above-referenced patent application be revived pursuant to 37 C.F.R. §1.137(b). As noted in MPEP section 711,03(c)(II)(C)(2), “‘unavoidable’ delay is the epitome of ‘unintentional’ delay.” Thus, not only was the delay in filing the enclosed reply due to unavoidable circumstances, i.e., non-receipt of the Office action dated March 19, 2004, but the entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was also unintentional.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



Stephen E. Kabakoff
Reg. No. 51,276
CESARI AND MCKENNA, LLP
88 Black Falcon Avenue
Boston, MA 02210-2414
(617) 951-2500

Exhibit A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
Theodore Spielberg)
Serial No.: 09/928,392)
Filed: August 13, 2001)
For: MICROPOROUS ENCAPSU-)
LATED ENDOCRINE CELL)
DISKS, BICONCAVE DISKS AND)
MULTIDIMPLED CHAMBERS)
FOR HORMONAL REPLACE-)
MENT)

Examiner: Nickol, G.

Art Unit: 1642

RECEIVED
JUN 03 2005
OFFICE OF PETITIONS

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
May 31, 2005

"Express Mail" Mailing-Label Number: EV 432397045 US

Mail Stop Petitions
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION OF STEPHEN KABAKOFF

I, Stephen Kabakoff, hereby submit this Declaration:

1. I reside at 1 Devonshire Street, Apt. 1510, Boston, Massachusetts 02109.

The facts stated herein are of my own personal knowledge, and if called to do so, I am competent and willing to testify to the truth of the same.

2. I am currently employed as a patent agent by the law firm of Cesari and McKenna, L.L.P., whose business address is 88 Black Falcon Avenue, Boston, Massachusetts 02210. My registration number is 51,276 for practicing before the U.S. Patent and Trademark Office (USPTO).

3. Cesari and McKenna maintains a docketing system in which all received Office actions are entered before they are distributed to the responsible attorneys and agents.

4. The docketing system entries are sorted based on their three-month due dates, and the lists of due dates are distributed to the responsible attorney and agents.

5. A list of cases whose responses were due between the dates of June 19, 2004 and June 21, 2004 is attached herewith as Exhibit A. As shown, only two cases were docketed having responses due in this time period: an annuity payment for attorney docket number 107059-0012 and a response to missing parts for attorney docket number 101141-0002.


6. The contents of the case files corresponding to attorney docket numbers 107059-0012 and 101141-0002 have been searched to determine whether they contain an Office action, mailed March 19, 2004, corresponding to the U.S. Patent Application Serial Number 09/928,392, entitled *Microporous Encapsulated Endocrine Cell Disks, Biconcave Disks and Multidimpled Chambers for Hormonal Replacement*, filed August 13, 2001.

7. As a result of the search, it was determined that the contents of the case files corresponding to attorney docket numbers 107059-0012 and 101141-0002 do not contain any Office actions corresponding to the above-noted U.S. Patent Application Se-

rial Number 09/928,392. Accordingly, the Office action mailed March 19, 2004, corresponding to the above-noted U.S. Patent Application Serial Number 09/928,392, was not misdocketed in either of the other case files having due dates between June 19, 2004 and June 21, 2004.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed on May 31, 2005



Stephen E. Kabakoff
USPTO Reg. 51,276

~~A~~

Page: 1

Filing Date

20-Dec-2002

03-Mar-2004

Title: METHOD OF SELLING AND DISTRIBUTING A SELF-CONTAINED DATABASE SYSTEM

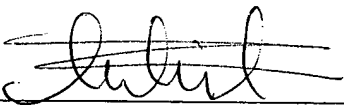
Exhibit 2

1. I reside at 52 Pearl Street, Watertown, Massachusetts 02472. The facts stated herein are of my own personal knowledge, and if called to do so, I am competent and willing to testify to the truth of the same.
2. I am currently employed by the law firm of Cesari and McKenna, L.L.P., whose business address is 88 Black Falcon Avenue, Boston, Massachusetts 02210. My current title is Docketing Clerk, a position I have held without interruption since June 2002.
3. As part of my job responsibilities, I record all mail sent to and received from the U.S. Patent and Trademark Office (USPTO) into a docketing system. I am the only employee at Cesari and McKenna who updates the contents of the docketing system in this manner.
4. The docketing system at Cesari and McKenna presently includes a record corresponding to the U.S. Patent Application Serial Number 09/928,392, entitled *Micro-porous encapsulated Endocrine Cell Disks, Biconcave Disks and Multidimpled Chambers for Hormonal Replacement*, filed August 13, 2001. The complete docketing record for this U.S. patent application is attached hereto as Exhibit A.
5. As shown in the attached Exhibit A, the only USPTO correspondence that I have docketed for U.S. patent application 09/928,392 since September 26, 2003, when our return postcard was received, is a Notice of Abandonment, mailed by the USPTO on December 2, 2004.
6. At no time have I entered a docketing entry corresponding to an Office Action received for U.S. Patent Application Ser. No. 09/928,392. If an Office Action had

been received by Cesari and McKenna, I would have recorded an appropriate entry in the docketing record attached hereto as Exhibit A.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed on December 21, 2004



Rocio Archila

A

Country Application

Friday, December 17, 2004

Client-Matter #: 15343-0028 **Country:** US **SubCase:** C3
Client: 15343 - THEODORE E. SPIELBER United States of America
Case Type: CON **Application Status:** Published
Application Number: 09/928,392 **Filing Date:** 13-Aug-2001
Patent Number: **Issue Date:**
Publication Number: 01-0049130 **Publication Date:** 06-Dec-2001
Priority Number: 09/397,780 **Priority Date:** 16-Sep-1999
Tax Schedule: LE **Expiration Date:**
Tax Start Date:
Agent:
Agent Reference Number:

RECEIVED

JUN 03 2005

OFFICE OF PETITIONS

Title: MICROPOROUS ENCAPSULATED ENDOCRINE
CELL DISKS BICONCAVE DISKS AND
MULTIDIMPLED CHAMBERS FOR HORMONAL
REPLACEMENT

List Of Actions

Action(s) Due	Due Date		Action Taken
N/A OB PC RE APPL FILED	13-Aug-2001	Due Date	13-Aug-2001
N/A RETURN PC RE APPL FILED	20-Aug-2001	Due Date	20-Aug-2001
PRELIMINARY AMENDMENT	24-Aug-2001	Reminder	26-Oct-2001
N/A FILING RECEIPT	27-Aug-2001	Due Date	27-Aug-2001
IDS	13-Nov-2001	Due Date	13-Nov-2001
ST CK F. RECEIPT	13-Nov-2001	Reminder	27-Aug-2001
PRELIMINARY AMENDMENT (CF 3	24-Nov-2001	Reminder	24-Nov-2001
IDS (CF 1 MO)	13-Dec-2001	Due Date	13-Dec-2001
N/A NOTICE OF PUBLICATION	17-Dec-2001	Due Date	17-Dec-2001
PRELIMINARY AMENDMENT-CF 4	24-Dec-2001	Reminder	21-Dec-2001
IDS (CF 2 MOS)	13-Jan-2002	Due Date	13-Jan-2002
PRELIM. AMEND (CF 5 MOS)	24-Jan-2002	Reminder	23-Jan-2002
IDS (CF 3 MOS)	13-Feb-2002	Due Date	13-Feb-2002
PRELIM. AMEND (CF 6 MOS)	24-Feb-2002	Reminder	24-Feb-2002
IDS (CF 4 MOS)	13-Mar-2002	Due Date	13-Mar-2002
PRELIM. AMEND (CF 7 MOS)	24-Mar-2002	Reminder	24-Mar-2002
IDS (CF 5 MOS)	13-Apr-2002	Due Date	13-Apr-2002

Country Application

Friday, December 17, 2004

PRELIM AMEND (CF 8 MOS)	24-Apr-2002	Reminder	24-Apr-2002
IDS (CF 6 MOS)	13-May-2002	Due Date	13-May-2002
PRELIM AMEND (CF 9 MOS)	24-May-2002	Reminder	24-May-2002
IDS (CF 7 MOS)	13-Jun-2002	Due Date	14-Jun-2002
PRELIM. AMEND (CF 10 MOS)	24-Jun-2002	Due Date	24-Jun-2002
IDS (CF 8 MOS)	13-Jul-2002	Due Date	12-Jul-2002
PRELIM AMEND (CF 11 MOS)	24-Jul-2002	Due Date	24-Jul-2002
IDS (CF 9 MOS)	13-Aug-2002	Due Date	13-Aug-2002
PRELIM AMEND (CF 12 MOS)	24-Aug-2002	Due Date	24-Aug-2002
IDS (CF 10 MOS)	13-Sep-2002	Due Date	13-Sep-2002
PRELIM AMEND (CF 13 MOS)	24-Sep-2002	Due Date	24-Sep-2002
N/A OFFICE ACTION	19-Dec-2002		19-Dec-2002
CU O.A.	30-Dec-2002	Reminder	02-Jan-2003
O.A TO CLIENT	06-Jan-2003	Due Date	17-Mar-2003
1 MOS O.A. DUE	16-Jan-2003	Due Date	17-Mar-2003
Application Status Check	13-Feb-2003	Due Date	19-Dec-2002
IDS (CF 15 MONTHS)	13-Mar-2003	Due Date	06-Dec-2004
N/A OFFICE ACTION	17-Mar-2003		17-Mar-2003
PRELIM AMEND (CF 17 MO)	24-Mar-2003	Due Date	24-Mar-2003
O.A. TO CLIENT	02-Apr-2003	Reminder	12-Jun-2003
CU O.A.	12-May-2003	Reminder	12-Jun-2003
N/A OB PC: OA RESP/AMDNMNT	12-Jun-2003		12-Jun-2003
O.A. DUE	12-Jun-2003	Due Date	12-Jun-2003
N/A RETURN PC MAILED: 6/12/03	23-Jun-2003		23-Jun-2003
N/A OFFICE ACTION	21-Aug-2003		21-Aug-2003
CU O.A.	02-Sep-2003	Reminder	19-Sep-2003
O.A TO CLIENT	09-Sep-2003	Due Date	19-Sep-2003
1 MO O.A. DUE	19-Sep-2003	Due Date	19-Sep-2003
N/A OB PC: OA RESP/AMDNMNT	19-Sep-2003		19-Sep-2003
N/A RETURN PC MAILED: 9/19	26-Sep-2003		26-Sep-2003
N/A ABANDONMENT	02-Dec-2004		02-Dec-2004
CU - PETITION TO REVIVE	02-Jan-2005	Reminder	
DUE: REVIVAL PETITION	02-Feb-2005	Due Date	

User ID: Jennifer

Date Created: 14-Aug-2001



Country Application

Friday, December 17, 2004

Last Update: 18-Dec-2001



Creation date: 07-29-2005
Indexing Officer: LCHEO - LEE CHEO
Team: OIPEBackFileIndexing
Dossier: 09928392

Legal Date: 06-14-2005

No.	Doccode	Number of pages
1	PETDEC	4

Total number of pages: 4

Remarks:

Order of re-scan issued on